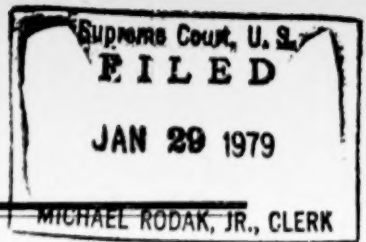


No. 78-788



In the Supreme Court of the United States
OCTOBER TERM, 1978

ESQUIRE, INC., PETITIONER

v.

BARBARA A. RINGER, REGISTER OF COPYRIGHTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA CIRCUIT*

**MEMORANDUM FOR THE RESPONDENT
IN OPPOSITION**

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1. Petitioner manufactures a line of outdoor lighting fixtures. In 1974 petitioner filed applications with the Copyright Office to obtain a copyright in the design of three lighting fixtures as "works of art" within the meaning of Section 5(g) of the then-applicable Copyright Act, 17 U.S.C. (1970 ed.) 5 (g). The Register of Copyrights refused to accept the applications. The Register determined that the

design of the fixtures was not copyrightable under the applicable regulations, 37 C.F.R. 202.10(c) (1976), because no element of the fixtures' design could "be identified separately [from the useful object] and [was] capable of existing independently as a work of art * * *" (*ibid.*).

Petitioner then brought suit in federal district court, seeking a writ of mandamus directing the Register to accept the applications. The district court granted the requested relief (Pet. App. A23). The court reasoned that the designs "are clearly art" and "to many they are more artistic than examples of sculpture found at such museums as the Corcoran or the Hirshhorn" (Pet. App. A26).

The court of appeals reversed (Pet. App. A1-A22). The court concluded that 37 C.F.R. 202.10(c) (1976) provided the correct legal standard of copyrightability in this context. That standard, as the court explained, is that

the overall design or configuration of a utilitarian object, even if it is determined by aesthetic as well as functional considerations, is not eligible for copyright.

Pet. App. A13. The court noted that 37 C.F.R. 202.10(c) (1976)—which provides that the design of a utilitarian article can be copyrighted only if that design consists of features "which can be identified separately and are capable of existing independently as a work of art"—was incorporated by Congress in the 1976 revision to the Copyright Act that now is in

effect (Pet. App. A11 n.23; see 17 U.S.C. App. 101 ¶ 20).¹

The court also held that the Register correctly applied the regulation in this case. The evidence did not establish that any identifiable feature of petitioner's fixtures was capable of existing independently as a work of art. The court concluded that the Register had not abused her discretion in denying the application for registration (Pet. App. A17-A18).

2. There is essentially no disagreement among petitioner, respondent, and the court of appeals about the legal standard applicable in this case. All agree that the design of utilitarian articles can be copyrighted, but only if those designs "can be identified separately and are capable of existing independently as a work of art." 37 C.F.R. 202.10(c) (1976). Petitioner's argument here, as in the courts below, is that its lighting fixture design is a "work of art" incorporated into a useful object. If petitioner's factual claim were correct, the design would be copyrightable under the regulations and under this Court's decision

¹ The court acknowledged that the 1976 Act does not apply to this case. Nevertheless, the court noted that (Pet. App. A11-A12) (footnotes omitted):

the new Act was designed in part to codify and clarify many of the regulations promulgated under the [earlier] Act, including those governing 'works of art.' Thus, the 1976 Act and its legislative history can be taken as an expression of congressional understanding of the scope of protection for utilitarian articles under the old regulations.

in *Mazer v. Stein*, 347 U.S. 201 (1954).² But petitioner's factual claim was rejected by the Register. As the court of appeals observed, this determination rests within the sound discretion of the Register (Pet. App. A17; see *Bailie v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958); *Bouve v. Twentieth Century-Fox Film Corp.*, 122 F.2d 51 (D.C. Cir. 1941)). That discretion was not abused in this case. There is no need for this Court to review petitioner's essentially factual disagreement with the Register and the court of appeals.

Petitioner argues nonetheless that an extremely broad test must be applied for determining when a design is a separately identifiable work of art. Under petitioner's theory (Pet. 8), the design of its fixtures is identifiable separately as art simply because it serves an "aesthetic purpose." Petitioner's contention, however, is fundamentally at odds with the limited objectives of the Copyright Act. The purpose of the Act is not to confer a monopoly on an aesthetically-designed useful article (Pet. App. A7-A8). If the Act were to be construed this broadly, industrial items that are consistently denied copyright status by the Register—such as cars, garments, furniture, or appliances—would be copyrightable, for aesthetic considerations enter into the design of these

² Petitioner argues (Pet. 8-9) that the court of appeals decision in this case conflicts with *Mazer* because it refuses registration of a work of art presented in utilitarian form. In *Mazer* this Court held that a work of art does not lose its copyrightable status merely because it has been incorporated

and most other useful objects (see Pet. App. A2).³ Such a revolutionary extension of copyright protection has been proposed to Congress on several occasions, but it has never been adopted (Pet. App. A7-A8 & n. 12). The legislative history of the recent amendments to the Act emphasized that:

* * * although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. * * * [E]ven if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful articles as such are copyrightable.

H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 55 (1976). There is thus no basis for petitioner's expansive interpretation of the protection afforded "works of art" under the Act.

into a useful object. But, as the court of appeals observed (Pet. App. A14-A15), *Mazer* does not answer the question presented in this case, which is whether petitioner's designs are separately identifiable works of art. As the court noted (Pet. App. A5), the regulation involved in this case is consistent with the principle established in *Mazer*.

³ See also Pet. App. A19 (Leventhal, J., concurring):

Form follows function, in the credo of one school of art. Yet the overall legislative policy against monopoly for industrial design sustains the Copyright Office in its effort to distinguish between the instances where the aesthetic element is conceptually severable and the instances where the aesthetic element is inextricably interwoven with the utilitarian aspect of the article.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.
Solicitor General

JANUARY 1979